



# UNITED STATES PATENT AND TRADEMARK OFFICE

B

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,956	01/25/2002	Eric McKinlay	50642.00027	8430

31894 7590 09/11/2006  
OKAMOTO & BENEDICTO, LLP  
P.O. BOX 641330  
SAN JOSE, CA 95164

EXAMINER

REILLY, SEAN M

ART UNIT PAPER NUMBER

2153

DATE MAILED: 09/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/056,956	<b>Applicant(s)</b> MCKINLAY ET AL.	
	<b>Examiner</b> Sean Reilly	<b>Art Unit</b> 2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-11 and 23-34 is/are allowed.
- 6) ☒ Claim(s) 12-22 and 35-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Another Examiner has been assigned to this application.

This Office action is in response to Applicant's amendment and request for reconsideration filed on June 15, 2006. Claims 1-41 are presented for further examination. Independent claims 35 and 39 have been amended. This action is made NON-FINAL due to the new 35 USC 101 rejection set forth.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- 1. Claims 12-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**
2. With regard to claims 12-22, Applicant claims multiple "logic" elements, which are software per se in view of Applicant's disclosure. A software program which is not tangibly embodied on a computer readable storage medium is merely a manipulation of abstract ideas and thus non-statutory.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**3. Claims 35-41 are rejected under 35 U.S.C. 102(b) as being anticipated by CNET (CNET's <http://www.download.com> webpage, October 1999; hereinafter CNET).**

With regard to claim 35, CNET disclosed a method for initiating a software download, the method comprising:

- Providing a web page to a client computer over a network (e.g. CNET's [www.download.com](http://www.download.com) homepage);
- Offering to provide a software application to a user of the client computer (e.g. the "Download Now" link that allows users to download the program flyswat); and
- Only if the user specifically agrees to receive the software application by so responding to a security prompt, downloading the software application to the client computer in chunks;

The above IF statement is false within the context of CNET's download.com homepage as the user never specifically agrees to download anything. Accordingly none of the related downloading limitations (including those found in dependent claims 37-38) must occur and thus CNET anticipates each limitation in claims 35-38. Similar rationale applies to claims 39-41. Applicant may overcome the CNET reference by rewriting the limitations in positive recitations that must be preformed.

***Allowable Subject Matter***

Claims 1-11 and 23-34 are allowed in view of Applicant's arguments filed June 15, 2006 and set forth on pgs 12 and 13. More specifically the prior art of record did not disclose the three

Art Unit: 2153

step process of downloading a software application: 1) downloading a browser plug-in with instructions to download a download manager program, 2) downloading a download manager program with instructions to download another software program using the browser plug-in and 3) finally downloading the intended software program in chunks using the download manager, in combination with the other claim limitations. Claims 12-22 would also be allowable for similar reasons if Applicant overcomes the outstanding 101 rejection.

### *Conclusion*

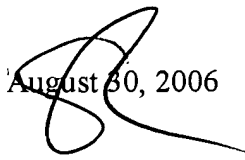
4. The prior art made of record, in PTO-892 form, and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Reilly whose telephone number is 571-272-4228. The examiner can normally be reached on M-F 8-5.

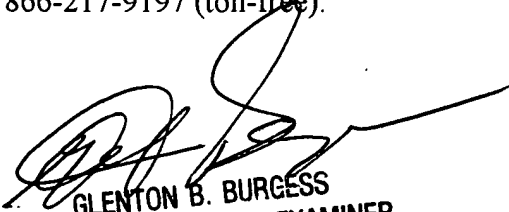
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2153

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



August 30, 2006



GLENTON B. BURGESS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100